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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,779	03/12/2004	David G. Filippi	COLME-0004	5631

7590
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02/20/2007

EXAMINER

CAJILIG, CHRISTINE T

ART UNIT

PAPER NUMBER

3637

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No. .

10/798,779

Applicant(s)

FILIPPI, DAVID G.

Examiner

Christine T. Cajilig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-79 is/are pending in the application.
- 4a) Of the above claim(s) 39-41 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-63, 65-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42, 55, 61-62, 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevens (U.S. Patent No. 6,735,907 B2).

Regarding claims 42 and 65, Stevens in Figures 2 and 3 discloses a gutter-cover system for spacing a wall (20, 22, 24) of a gutter (4) from a gutter cover (2) comprising a cover (2), said cover comprising a solid sheet (2) having one longitudinal edge thereof formed into a curl (12) and wherein the cover (2) extends downwardly and outwardly from the lowermost edge of a roof (8) so that said curl (12) extends downwardly toward said gutter (4); a gutter-cover clip (34) having a substantially flat body portion (a) inherently having a thickness; said body portion (a) comprising a first throat portion (36) having first (52) and second (38) jaws thereof and shaped so that said first throat (36) portion is adapted to engage said curl (12) of said cover (2); third (b) and fourth (40) jaws and a second throat (c) located therebetween, said second throat (c) being adapted to engage said wall (22, 24) of said gutter (4) between said third (b) and fourth (40) jaws; and, at least a first locking lever (d) adjacent said third jaw (b) and joined to

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said body (a) portion by a hinge (e), said first locking lever (d) being adapted to be bent at said hinge (e) to bring said third jaw (b) into a locking position against said gutter (4) as seen in Figure 2.

Regarding claim 55, Stevens in Figure 2 discloses a gutter-cover system wherein said clip (34) is adapted to lock onto a vertical gutter wall portion (throat 40 in Figure 5a is capable of locking onto a vertical gutter wall) and wherein said third (b) and fourth (40) jaws are essentially parallel to said vertical gutter wall (24). No patentable weight is given to the structure of a gutter since the gutter is claimed as an intended use.

Regarding claim 61, Stevens discloses a gutter-cover system wherein said body portion is comprised of a flat piece of metal that is inherently bendable (Col 5, Ln 45-48).

Regarding claim 62, Stevens in Figures 2 and 3 discloses a gutter-cover system wherein the deepest part (f) of said first throat (36) and the deepest part (g) of said second throat (c) lie essentially in a common plane.

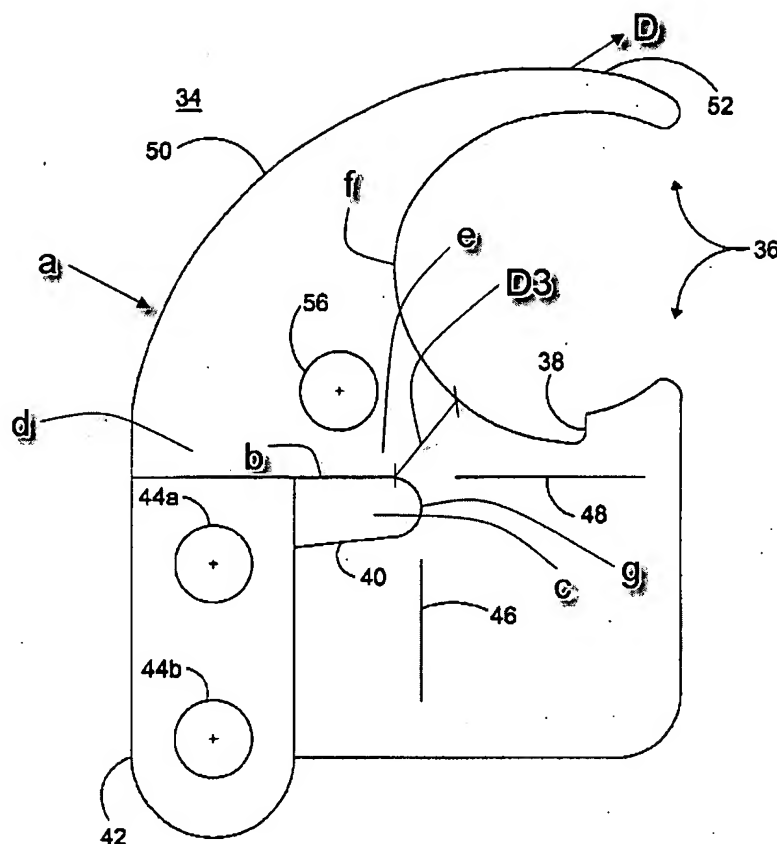


FIG. 3

Stevens (U.S. Patent No. 6,735,907 B2)

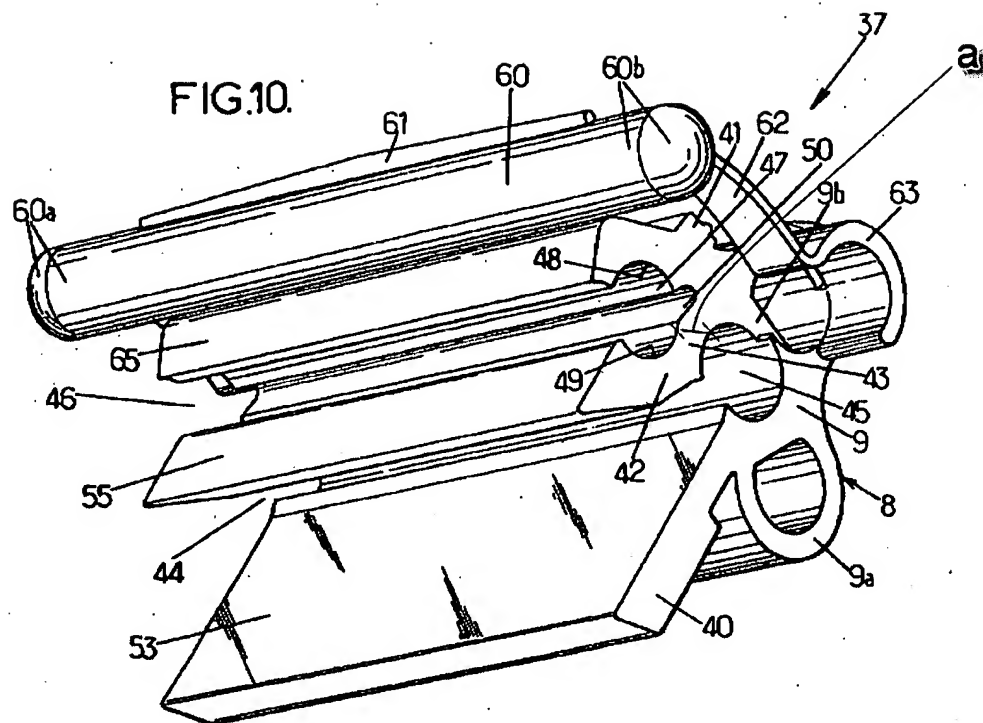
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-48, 56, 63, 66-69, and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Doussot et al. (U.S. Patent No. 5,426,832).

Regarding claim 43, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot, said hinge having a width (D3) whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), said bending slot (46) being located above a second throat (45) so that a hinge (43) is between said second throat (45) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Stevens and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot and having a width (D3) whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).



Doussot et al. (U.S. Patent No. 5,426,832)

Regarding claim 44 and 45, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 7/64 inch, preferably about 3/32 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the width of said hinge (D3) to be between about 1/16 inch and 7/64 inch, preferably about 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally

recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 46, 47, 68, and 69, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the hinge width (D3) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the hinge width (D3) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall while being able to support more length of the gutter cover. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 48, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above and further discloses a locking slot (56) inherently capable of accommodating a locking-unlocking tool for selectively pivoting said locking lever (d) about said hinge (D3) and into a lock or unlocked position.

Regarding claim 56, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third jaw and said bending slot whereby a force applied to said bending slot moves said

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locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37) located adjacent said third jaw (57) so that a hinge (43) is between said third jaw (57) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Stevens and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third wall and said bending slot whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).

Regarding claims 63 and 66, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion located above said second throat and wherein the ratio of the distance between said first throat and said bending slot to the thickness of said hinge is between about 1.1 and 2.0. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), and said bending slot (46) being located above a second throat (45). Stevens and Doussot et al.

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are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion and said bending slot being located above said second throat as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17). Furthermore, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be between about 1.1 and 2.0, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 67, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein said ratio of the distance between said first throat and said bending slot to the thickness of said hinge is preferably about 1.5. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with

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gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 74, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 3/32 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the width of said hinge (D3) to be between about 1/16 inch and 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 75, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above and further discloses that said first hinge (e) is between said second throat (c) and said bending slot, and said third jaw (b) clamps onto said wall (22) of said gutter (4) upon insertion and rotation of a bending tool in said bending slot per the modification in claim 63, but does not disclose the width (D6) being the shortest distance between said first throat and said bending slot. However, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have disclose the width (D6) being the shortest distance between said first throat and said bending slot, since such a modification would have

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involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The phrase "upon insertion and rotation of a bending tool in said bending slot" is regarded to as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP §2114. Furthermore, the third jaw could perform the function stated above if any tool applies downward pressure.

Regarding claim 76, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D6) is preferably about 15/128 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the width (D6) preferably about 15/128 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 77 and 78, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, and preferably about 1.5. It would have been an obvious matter of design

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choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, and preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 79, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the distance (D8) between said first throat (36) and said second throat (c) is 19/128 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the distance (D8) between said first throat and said second throat to be 19/128 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Holbrook (U.S. Patent No. 6,347,780 B1).

Regarding claims 50 and 54, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including at least

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one of said jaws being serrated. However, Holbrook in Figure 6 discloses gutter hanger clip including two serrated jaws. Stevens and Holbrook are analogous art because they are pertinent in the problem of clamping the top front wall of the gutter. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include serrations in the third and fourth jaws as taught by Holbrook to provide better retention of the clip when in contact with the gutter surface (Col 3, Ln 9-11 and Ln 45-48).

Claims 51-53 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 51, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge, said second locking lever being adapted to be bent at said second hinge to bring said fifth jaw into a locking position against a vertical wall of said gutter. However, per Applicant's admission in page 4, including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts, such as the duplication of the jaws, has

no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claims 52 and 53, Stevens already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch. However, per Applicant's response in page 4, including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the shortest distance (D4) between said first throat and said third throat to be between about 1/8 and 7/16 inch, preferably about 5/16inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally

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recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 57 and 58, Stevens already modified by Figures 5-11 of the Applicant's disclosure discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch, preferably about 3/32 inch. However, per Applicant's response in page 4, including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the width (D2) of said second hinge to be between about 1/16 inch and 5/32 inch, preferably about 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the

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gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 59 and 60, Stevens already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the hinge-width (D2) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the ratio of the hinge-width (D2) to the thickness (D) of said body portion to be between about 0.25 and 1.2 inch, preferably about 0.94 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall while being able to support more length of the gutter cover. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 49 and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Doussot et al. and in further view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 49, Stevens already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system

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further including a recess in said third jaw for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter. However, per Applicant's response in page 4, including a recess in said third jaw would have been obvious in view of Figures 8 and 9 in the Applicant's disclosure for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter.

Regarding claim 70, Stevens already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws. However, per Applicant's response in page 4, including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the

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level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claim 71, Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D7) of said second hinge is preferably about fraction $11/128$ inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure to have the width (D7) of said second hinge to be preferably about fraction $11/128$ inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 72 and 73, Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the distance between the first and second throats is (D8) and the width of said second hinge is (D7) and the ratio of (D8) to (D7) is between about 1.1 and 2.0, preferably about 1.5. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure to have the ratio of (D8) to (D7) to be between about 1.1 and 2.0, preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the

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clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

Applicant's arguments, see page 17, filed 12/07/06, with respect to claim 55 and claim 56 which is dependent therefrom have been fully considered and are persuasive. The 35 U.S.C. 112, first paragraph of claim 55 has been withdrawn.

Regarding Applicant's argument that Stevens does not disclose each and every element of the independent claims 42 and 65 and dependent claim 55, the Examiner respectfully disagrees. Applicant argues that Stevens does not have a hinge or a locking lever. See Remarks page 19-20. However, per the explanation of the 35 U.S.C. 102 rejection above, Stevens clearly shows a hinge, which is the narrow section (e) of clip. Furthermore, the locking lever (d) is clearly in the clip of Stevens and is adapted to be bent at the hinge (e). The clip of Stevens is constructed from a flat piece of metal, which inherently would make the clip of Stevens capable of bending the lever (d) at the hinge (e). Applicant also argues that the clip of Stevens requires a fastener and that Applicant's clip does not. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the lack of a fastener) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

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F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to claim 55, see the explanation of the rejection above. Accordingly, the 35 U.S.C. 102 rejection is deemed proper.

In response to applicant's argument that Stevens and Doussot et al. and Holbrook is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Doussot et al. discloses a clip for use in a vehicle seat. Doussot et al.'s clip is used to securely engage a rod (4) by locking the rod in the throat of the clip via a lever (42), thus securing it in place. Moreover, both Stevens and Doussot et al. solve the problem of securing a member in the jaws of a clip. Holbrook discloses a hanger clip to securely fasten lights onto a gutter. Holbrook's clip uses serrated teeth on its jaws to securely engage a gutter. Moreover, both Stevens and Holbrook solve the problem of securing a member in the jaws of a clip. Furthermore, classification is not conclusive evidence of whether art is analogous or not. See MPEP 2141.01. Thus, the Examiner maintains that all clips that are capable of holding on to a structure are in Applicant's field of endeavor. Accordingly, the Stevens, Doussot et al., and Holbrook are analogous.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner's obviousness rejections take into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made. This is evidenced by the fact that the teachings and suggestions relied upon in making those rejections were taken solely from the prior art references, or from case law setting forth those modifications that are generally recognized as being within the level of ordinary skill in the art. The Examiner's obviousness rejections did not include knowledge gleaned only from the Applicants' disclosure. Thus, because the Examiner's obviousness rejections take into account only knowledge within the level of ordinary skill in the art, and do not include knowledge gleaned only from Applicant's disclosure, the Examiner's reconstruction is proper and is not impermissible hindsight.

Applicant also argues that "the Office Action does not provide a reason for modifying the references cited by the Examiner in the manner suggested by the Examiner except to arrive at Applicant's specifically defined construction, taught only by Applicant's disclosure." Remarks, page 27. The Examiner respectfully disagrees. The Office Action provides reasons for modifying the references in each instance that a modification is made, and the reasons for modifying the references were found independent from Applicant's disclosure. For example, the reasons provided in the Office Action rely on teachings or suggestions explicitly provided in the references

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themselves, or rely on knowledge that was within the level of ordinary skill in the art.

Since the reasons for modifying the references were not taught only by Applicant's disclosure, the reconstruction used by the Examiner was proper. See MPEP 2145.

With regard to Applicant's argument on page 27 of the Remarks, that "statements such as 'it would have been an obvious design choice' do not provide the type of objective evidence of a teaching, suggestion, or motivation," the Examiner respectfully disagrees. There is no requirement that an express, written motivation to combine must appear in prior art references before a finding of obviousness, and that motivation to combine prior art references may exist in the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. See MPEP 2145. In the Office Action, the teachings, suggestions, and motivations provided by the cited references and the cited case law are evidence of knowledge that is possessed by one of ordinary skill in the art. Thus, the Examiner's statements are sufficient for establishing ordinary skill in the art, and the rejections were proper reconstruction and not impermissible hindsight.

Finally, by virtue of Applicant's own admission provided in Applicant's reply to Restriction Requirement, various embodiments of the invention are obvious in relation to one another. The Office Action takes the position that if one of those embodiments were found to be obvious to one of ordinary skill in the art, then the remaining embodiments (which Applicant admits are only obvious variants of the one embodiment) would also be obvious to one of ordinary skill in the art. See MPEP 818. Accordingly, since one embodiment of the invention was rejected for obviousness in the Office

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Action, then the same rejection also applies to the other embodiments of the invention that Applicant admits are only obvious variations.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elko et al. (U.S. Patent No. 4,455,791 A), a gutter cover clip with channels for receiving gutter wall and gutter cover; Sweet (U.S. Publication No. 2002/0069594 A1), a clip for attaching a gutter cover without the use of screws.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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